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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MORRISON, THOMAS A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/657,130	TADA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas A. Morrison	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/02/2004</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species I (Figures 1-19) directed to claims 1-14 and 19, in the reply filed on June 6, 2005 is acknowledged.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least two sensors set forth in claim 3 and the shift transportation roll set forth in claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 3653

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The indefiniteness problems outlined below are merely exemplary. Applicant should review the claims and make the language consistent throughout the claims.

Regarding claim 1, it is unclear how many sheet transportation paths are claimed. Is the recited "a sheet transportation path" in line 2 the same or different from the recited "a sheet transportation path" in line 4?

Also, it is unclear which sheet transportation path is referred to in lines 6-7.

Moreover, it is unclear how many base members are claimed. Is the recited "a base member" in line 9 the same or different from the recited "a base member" in line 14?

Regarding claim 2, it is unclear in lines 3-4, which previously recited sheet transportation path is referred to in claim 1. Does claim 2 refer back to the recited "a sheet transportation path" in line 2 of claim 1?

Regarding claim 4, there is insufficient structure recited in this claim, to understand how the first adjusting mechanism or the second adjusting mechanism can adjust the sheet regulation position of the side position regulating mechanism manually and/or automatically.

Regarding claim 5, it is unclear what is meant by the recited "a coarse adjustment step" and the recited "a fine adjustment step".

Regarding claim 6, there is insufficient structure recited in this claim, to understand how an operation for the fine adjustment step is linked with an operation for the coarse adjustment step.

Regarding claim 7, there is insufficient structure recited in this claim, to understand how the sheet position regulation by the side position regulating mechanism can be performed while combinedly using the first adjusting mechanism and the second adjusting mechanism.

Also, it is unclear in claim 7, what is meant by the recited "while combinedly using the first adjusting mechanism and the second adjusting mechanism".

Regarding claim 8, there is insufficient structural relationship recited between the elements (e.g., the reference member, the swing fulcrum and the base member) to understand how the first adjusting mechanism supports the reference member, as claimed.

Regarding claim 11, it is unclear in line 4 of this claim, which base member is referred to back in claim 1. Does the recited "the base member" in line 4 of claim 11 refer back to the previously recited "a base member" in line 9 of claim 1?

Regarding claim 13, there is insufficient structure recited in this claim, to understand how the controlling device adjusts at least one of the first adjusting mechanism and the second adjusting mechanism.

Also, it is unclear what is meant by the recited "usage conditions of the sheet".

Regarding claim 14, it is unclear what it meant by the recited "a direction of a sheet transportation face is used as a sheet usage condition".

Regarding claim 19, it is unclear how many sheet transportation paths are claimed. Is the recited "a sheet transportation path" in line 2 the same or different from the recited "a sheet transportation path" in lines 3-4? Also, is it the same or different from the recited "a sheet transportation path" in line 6?

Also, it is unclear which sheet transportation path is referred to in lines 8-9.

Moreover, it is unclear how many base members are claimed. Is the recited "a base member" in line 11 the same or different from the recited "a base member" in line 16?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4-7, 9-13 and 19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 4-7264. In particular, Japanese Publication No. 4-7264 discloses all of the limitations of claims 1, 4-7, 9-13 and 19.

Regarding claim 1, Figs. 1-7 show a sheet transporting apparatus (28), including

- a sheet transportation path (through 28, out of 5 and onto base portion 2);
- a predetermined number of transport members disposed in a sheet transportation path (i.e., inherently there are transport members inside 28, which move the sheet 1 along the transport path and onto the base portion 2. Fig. 4 clarifies that the sheet 1 moves along the sheet transport path in the direction A);
- a side position regulating mechanism (including 8a, 8b, 21) which regulates a position of a side edge of a sheet in the sheet transportation path, the side position regulating mechanism having a reference member (including 8a, 8b and 21) configured to change a sheet regulation position;
- a base member (including 2 and 6) on which at least the reference member (including 8a, 8b and 21) is mounted;
- a first adjusting mechanism (Fig. 3 and English Abstract) which adjusts a position of the reference member (including 8a, 8b and 21); and
- a second adjusting mechanism (Fig. 3) which adjusts a position of a base member (including 2).

Regarding claim 4, Fig. 3 shows that the first adjusting mechanism or the second adjusting mechanism can adjust the sheet regulation position of the side position regulating mechanism (including 8a, 8b, 21), in one or both of manual and automatic manners.

Regarding claim 5, Figs. 2 and 7 show that one of the first adjusting mechanism (Fig. 3 and English Abstract) and the second adjusting mechanism (Fig. 3) can perform the adjustment by a coarse adjustment step, and the other can perform the adjustment by a fine adjustment step.

Regarding claim 6, Figs. 2 and 7 and the English Abstract disclose that among the first adjusting mechanism (Fig. 3 and English Abstract) and the second adjusting mechanism (Fig. 3), an operation for the fine adjustment step is linked with an operation for the coarse adjustment step.

Regarding claim 7, the "Purpose" section of the English Abstract discloses that the sheet position regulation by the side position regulating mechanism (including 8a, 8b, 21) is performed while combinedly using the first adjusting mechanism (Fig. 3 and English Abstract) and the second adjusting mechanism (Fig. 3).

Regarding claim 9, Figs. 2-3 and 7 show that the second adjusting mechanism (Fig. 3) supports the base member (including 2) swingably around a swing fulcrum (7).

Regarding claim 10, Fig. 3 shows that the first adjusting mechanism includes a drive source (including 14) and a driving transmitting mechanism (including 10 and 9); and



the drive source (including 14) is coupled to the reference member (including 8a, 8b and 21) via the driving transmitting mechanism (including 10 and 9).

Regarding claim 11, Fig. 3 shows that the second adjusting mechanism includes a drive source (including 14) and a driving transmitting mechanism (including 10 and 16); and

the drive source (including 14) is coupled to the base member (including 2) via the driving transmitting mechanism (including 10 and 16).

Regarding claim 12, inherently there is a controlling device which controls the first adjusting mechanism and the second adjusting mechanism.

Regarding claim 13, Figs. 2 and 7 show that, in accordance with usage conditions of the sheet (1), the controlling device adjusts at least one of the first adjusting mechanism and the second adjusting mechanism.

Regarding claim 19, Figs. 1-7 show a sheet processing apparatus (28), including

- a sheet transportation path (through 28, out of 5 and onto base portion 2);
- a sheet processing section (inside 28) disposed in a sheet transportation path;
- a predetermined number of transport members disposed in a sheet transportation path (i.e., inherently there are transport members inside 28, which move the sheet 1 along the transport path and onto the base portion 2. Fig. 4 clarifies that the sheet 1 moves along the sheet transport path in the direction A);

a side position regulating mechanism (including 8a, 8b, 21) which regulates a position of a side edge of a sheet (1) in the sheet transportation path, the side position regulating mechanism (including 8a, 8b, 21) having a reference member (including 8a, 8b and 21) configured to change a sheet regulation position;

a base member (including 2 and 6) on which at least the reference member (including 8a, 8b and 21) is mounted;

a first adjusting mechanism (Fig. 3 and English Abstract) which adjusts a position of the reference member (including 8a, 8b and 21); and

a second adjusting mechanism (Fig. 3) which adjusts a position of a base member (including 2).


### ***Conclusion***

5. The fact that the examiner has not rejected all of the claims in view of prior art should not be construed to mean that such claims contain allowable subject matter, particularly in view of the 35 U.S.C. 112, second paragraph rejection above. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6944. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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